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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH ARNESON, JOHN CLARK, and
LAWRENCE J. CORVARI

Appeal 2008-2563
Application 09/853,187
Technology Center 2400

Decided: October 29, 2008

Before LANCE LEONARD BARRY, JEAN R. HOMERE, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-68. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

THE INVENTION

Appellants' invention relates generally to the field of event notification. More specifically, Appellants' invention is directed to a system and method of notifying a remotely located entity user of an occurrence of an event (Spec. 1).

Independent claim 1 is illustrative:

1. A method of providing electronic event notification to a communications device, comprising:
 - associating a first electronic event message indicating a change associated with a predefined Internet site content with a first phone number such that information about said first electronic event message is provided when a communications device calls said first phone number;
 - sending said first phone number to said communications device; and
 - providing information about said first electronic event message when said communications device calls said first phone number.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the obviousness rejection:

Helferich	US 6,636,733 B1	Oct. 21, 2003
Rajan	US 6,633,910 B1	Oct. 14, 2003

THE REJECTION

Claims 1-68 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Helferich in view of Rajan.

APPELLANTS' CONTENTIONS

1. Appellants contend that the Examiner erred in rejecting claims 1-68 under 35 U.S.C. §103(a) because neither Helferich nor Rajan teach or suggest providing a phone number that, when called, provides information about the change associated with predefined Internet site content (App. Br. 7).
2. Appellants contend that the Examiner further erred in rejecting claims 11-27 and 32-59 and 62-68 under 35 U.S.C. §103(a) because neither Helferich nor Rajan teach or suggest a system and method of associating at least one claim check with an event indicating a change associated with predefined Internet site content (App. Br. 10).
3. Appellants contend that the Examiner further erred in rejecting claims 1-68 under 35 U.S.C. §103(a) because that is no suggestion or motivation to combine the Helferich and Rajan references (App. Br. 8-9).

ISSUES

1. We consider the question of whether Appellants have shown that the Examiner erred in finding that the combination of Helferich and Rajan teaches or suggests providing a phone number that, when called, provides information about the change associated with predefined Internet site content.
2. We consider the question of whether Appellants have shown that the Examiner erred in finding that the combination of Helferich and Rajan teaches or suggests a system and method of associating at least one claim check with an event indicating a change associated with predefined Internet site content.
3. We consider the question of whether Appellants have shown that the Examiner erred in rejecting claims 1-68 under 35 U.S.C. §103(a) because there is purportedly no suggestion or motivation to combine the Helferich and Rajan references.

PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*,

441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants’ Briefs to show error in the proffered *prima facie* case.

FINDINGS OF FACTS

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

The Helferich reference

1. Helferich teaches a wireless mobile telephone is used as a messaging device (col. 3, ll. 16-18).
2. Helferich teaches, according to one embodiment, that an e-mail server assigns a message to a telephone callback number (col. 4, ll. 8-10).
3. Helferich teaches that the user can send a reply message to the sender of the e-mail message by activating a reply command that automatically places a call from the mobile phone to the callback number (col. 4, ll. 32-37).

The Rajan reference

4. Rajan teaches monitoring changes in Internet site content by sending notification alerts of such Internet site content changes to user devices such as cell phones that have associated phone numbers (col. 3, ll. 44-46; 60-65).

5. Rajan teaches that an output template is used that is associated with the format of the receiving device (col. 17, ll. 1-2).
6. Rajan teaches, according to one embodiment, that the requested notification of Internet site content changes may also be sent to a paging device (col. 17, ll. 9-12).

ANALYSIS

Issue 1

We decide the question of whether Appellants have shown that the Examiner erred in finding that the combination of Helferich and Rajan teaches or suggests providing a phone number that, when called, provides information about the change associated with predefined Internet site content.

Appellants attempt to support their first contention by asserting that Helferich discloses a user of a wireless messaging device receiving notification of an e-mail awaiting retrieval, with no disclosure or suggestion of monitoring Internet site content, much less a change associated with a predefined Internet site content (App. Br. 7, ¶3).

However, we note that the Examiner relies on Rajan for the teaching of monitoring Internet site content by sending alerts of data changes at Internet sites to user devices such as cell phones (FF 4). One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Regarding Appellants' discussion of the secondary Rajan reference, we find Appellants' statement that "Rajan relies on an e-mail notification NOT a phone number" to be an incomplete assessment of the teachings of the Rajan reference (App. Br. 8, ¶2). To the contrary, we find that Rajan clearly teaches providing information about the change associated with a predefined Internet site to a cell phone having a phone number (FF 4). Rajan further teaches that an output template is used that is associated with the particular format of the receiving device (FF 5). Rajan also teaches, according to one embodiment, that the requested notification of Internet site content changes may also be sent to a paging device (col. 17, ll. 9-12). We find the primary Helferich reference clearly teaches a telephone callback number (FF 2-3). The Examiner's rejection is based on the *combination* of the references. We conclude that an artisan possessing ordinary skill, common sense, and creativity would have found it obvious to substitute a callback (as taught by Helferich) in the system taught by Rajan.¹ Therefore, for the reasons set forth by the Examiner in the Answer, as further embellished upon by our discussion above, we find that the *combination* of Helferich and Rajan teaches and/or suggests the argued limitations of providing a phone number that, when called, provides

¹ "It is common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR*, 127 S. Ct. at 1732. Courts should "take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 127 S. Ct. at 1741.

information about the change associated with predefined Internet site content. Accordingly, we conclude that Appellants have not shown the Examiner erred.

Issue 2

We decide the question of whether Appellants have shown that the Examiner erred in finding that the combination of Helferich and Rajan teaches or suggests a system and method of associating at least one claim check with an event indicating a change associated with predefined Internet site content.

Claim Construction

During prosecution, “the PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)).

When we look to Appellants Specification for *context*, we note that a “claim check” is described as follows:

Therefore, a claim check is a unique per event message for a particular user, but may advantageously be shared across event messages for one or more other users.
(Spec. 16, ll. 15-17).

Consistent with Appellants’ Specification, we broadly but reasonably construe the recited “claim check” as a *message for one or more users*. Given the aforementioned construction, we find the scope of Appellants’ “claim check” broadly encompasses Rajan’s teaching of notification alerts (i.e., messages) that are sent to user devices (such as cell phones) when

changes in Internet site content have been detected (FF 4). Therefore, we find that the combination of Helferich or Rajan teaches and/or suggests the argued limitations of a system and method of associating at least one “claim check” with an event indicating a change associated with predefined Internet site content. Accordingly, we conclude that Appellants have not shown the Examiner erred.

Issue 3

We decide the question of whether Appellants have shown that the Examiner erred in rejecting claims 1-68 under 35 U.S.C. §103(a) because there is purportedly no suggestion or motivation to combine the Helferich and Rajan references.

We have fully considered Appellants’ arguments regarding a purported lack of a suggestion or motivation to combine the references. However, we find Appellants’ arguments to be unpersuasive. To the contrary, we find that the combination of Helferich and Rajan requires no more than arranging known elements that perform their known functions to achieve predictable and expected results (i.e., sending a message to alert a user that Internet site data content has changed (Rajan FF 4) and providing a phone number to be called (Helferich FF 2)). We note that in *KSR*, the Supreme Court reaffirmed that “[w]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an

arrangement, the combination is obvious.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. at 1740 (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)). Accordingly, we conclude that Appellants have not shown the Examiner erred.

Claim Grouping

Appellants have argued *Issues 1* and 3 with respect to all claims on appeal (claims 1-68). Appellants have argued *Issues 2* and 3 with respect to claims 11-27 and 32-59 and 62-68, which stand or fall together. We find that Appellants have not shown the Examiner erred regarding each of *Issues 1, 2, and 3*, as discussed *supra*.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not met their burden of showing that the Examiner erred in rejecting claims rejecting claims 1-68 under 35 U.S.C. §103(a) for obviousness.

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DECISION

We affirm the Examiner's decision rejecting claims 1-68. Therefore, claims 1-68 are not patentable.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

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